

### Remarks

Reconsideration and withdrawal of the rejections of the claims, in view of the amendments and remarks herein, is respectfully requested. Claims 5-6 and 26 are amended, and claim 29 is canceled. The amendments are intended to advance the application and are not intended to concede to the correctness of the Examiner's position or to prejudice the prosecution of the claims prior to amendment, which claims are present in a continuation of the above-identified application. Claims 5-6, 20-22, and 26-27 are pending.

The Examiner rejected claims 5-6, 20-22 and 26-27 under 35 U.S.C. § 112(1) as failing to comply with the written description requirement. The amendments to the claims render the § 112(1) rejection moot.

The Examiner also rejected claims 26-27 under 35 U.S.C. § 102(b) as being anticipated by Sundarraj et al. (FEBS Letters, 85:47 (1978)) as evidenced by the abstract of Crawford et al. (Virology, 24:388 (1964)) and page 113, lines 4-9 in Graessman et al. (In: Cell Transformation, Celis and Graessman, eds. pp. 113-126 (1984)). This rejection, as it may be maintained with respect to the pending claims, is respectfully traversed.

Sundarraj et al. compared the post-translational modifications of procollagen in an SV40-transformed human fibroblast line to the post-translational modifications of procollagen in an untransformed normal diploid fibroblast line. The abstract for Crawford et al. discloses that two components with differing sedimentation coefficients were identified after extraction of SV40 DNA, and Graessman et al. relate the transformation capacity of DNA fragments of SV40.

None of Sundarraj et al., the abstract for Crawford et al. or Graessman et al. disclose an isolated host cell comprising a recombinant nucleic acid for a vertebrate DNA repair protein. Therefore, withdrawal of the § 102(b) rejection is respectfully requested.

The Examiner further rejected claims 5-6, 20-22, 26-27, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Maser et al. (Mol. Cell. Biol., 17:6087 (1997)), in view of Varon et al. (Cell, 93:467 (1998)) and Carney et al. (Cell, 93:477 (1998)). This rejection is respectfully traversed.

The present application claims the benefit of the filing date of U.S. application Serial No. 09/067,641, filed April 27, 1998. The Varon et al. and Carney et al. articles were published in the same volume of Cell. As stated in the Rule 132 Declaration of Ms. Koch enclosed herewith,

the volume of the journal Cell in which the Varon et al. and Carney et al. articles appeared was first publicly available on either April 30, 1998 or May 1, 1998. Therefore, the Varon et al. and Carney et al. articles are not prior art to the present application.

Using ionizing radiation and immunofluorescence, Maser et al. found that hMrell and hRad50 form discrete nuclear foci in human fibroblasts in response to treatment with DNA double-strand break inducing agents (abstract). Maser et al. do not teach or suggest an isolated vertebrate DNA repair protein having a molecular weight of about 95,000. Therefore, withdrawal of the § 103 rejection is appropriate and respectfully requested.

The Examiner provisionally rejected claims 5-6, 20-22, 26-27, and 29 under the judicially created doctrine of obviousness-type double patenting over claims 1-2, 4, 20-24, and 26-28 of co-pending application Serial No. 09/837,602 in view of Varon et al. and Carney et al. As discussed hereinabove, Varon et al. and Carney et al. are not prior art to the pending application. The present application and the '602 application are divisions of U.S. application Serial No. 09/067,641. The claims in the '641 application were restricted into Groups I-VII, and Applicant elected the claims in Group IV (claims 9 and 19), directed to antibodies specific for a DNA repair polypeptide of about 95 kDa, for prosecution on the merits in that application. The claims in Group I (claims 1-4), directed to nucleic acid encoding a DNA repair polypeptide of about 95 kDa, of the '641 application appear in the '602 application, and a subset of the claims in Group II (claims 5-6 and 16-18), directed to altering the level of a DNA repair polypeptide of about 95 kDa in cells, appear in the present application. 35 U.S.C. § 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made or an application filed as a result of such a requirement, as a reference against the divisional application. M.P.E.P. 804.01. Accordingly, withdrawal of the obviousness-type double patenting over claims 1-2, 4, 20-24, and 26-28 of co-pending application Serial No. 09/837,602 is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6959) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

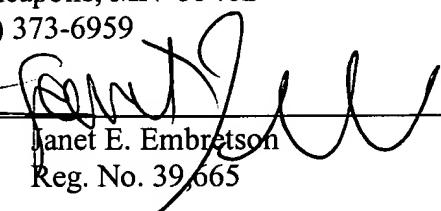
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Date

July 5, 2005

By   
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Reg. No. 39,665

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5th day of July, 2005.

Name

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Signature

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